

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Timo Juhani Kangas

Application No.: 10/088,926

Confirmation No.: 2678

Filed: March 20, 2002

Art Unit: 3625

For: METHOD AND ARRANGEMENT FOR  
DISTRIBUTING INFORMATION AND  
SERVICES THROUGH A NETWORK

Examiner: J. H. Zurita

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO THE NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Sir:

Responsive to the Notice mailed April 18, 2007, entry of the Amended Appeal Brief submitted concurrently herewith is respectfully requested.

The Notice indicates that the Amended Appeal Brief filed February 20, 2007 is non-compliant for not containing items required by 37 C.F.R. § 41.37(c)(1)(v). In particular, the Notice indicates that independent claim 8 should be explicitly mentioned and mapped to the specification. The Summary of Claimed Subject Matter has been appropriately amended by including the numeric “8” in the first line of the first paragraph on page 4 of this Amended Appeal Brief.

Applicants submit that the Amended Appeal Brief, submitted herewith, is fully compliant with the requirements of 37 C.F.R. § 41.37. Each and every point raised in the Notice of Non-Compliant Appeal Brief, has been addressed in this Amended Appeal Brief.

This response to the Notice of Non-Compliant Appeal Brief, and the Amended Appeal Brief, concurrently submitted herewith, should be considered because they are both being filed concurrently with a Petition for Extension of Time and payment of the required fee. However, the Commissioner is hereby authorized to charge any fees deemed required in connection with this submittal to Deposit Account No. 04-0100.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Katz', is written over a horizontal line.

Richard J. Katz  
Reg. No. 47,698  
Attorney for Applicants

Dated: May 11, 2007

DARBY & DARBY, . P.C.  
Post Office Box 5257  
New York, N.Y. 10150-5257  
Phone: (212) 527-7700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Timo Juhani Kangas

Application No.: 10/088,926

Confirmation No.: 2678

Filed: March 20, 2002

Art Unit: 3625

For: METHOD AND ARRANGEMENT FOR  
DISTRIBUTING INFORMATION AND  
SERVICES THROUGH A NETWORK

Examiner: J. H. Zurita

**APPELLANTS' AMENDED BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this Amended Brief in accordance with 37 C.F.R. § 41.37 in support of their appeal from the Final Office Action, mailed December 15, 2005 by Examiner Khanh Q. Dinh, and the Advisory Action, mailed June 7, 2006, in the above-identified patent application.

In accordance with 37 C.F.R. §§ 41.31 and 41.37, this brief follows the June 15, 2006 filing of a Notice of Appeal and payment of the required fee. This brief is in support of said Notice of Appeal. Appellants submit that this Appeal Brief is timely filed, and requires no extension of time fee. However, the Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this Appeal Brief, or to credit any overpayment, to Deposit Account No. 04-0100.







## VII. ARGUMENT

Grounds of Rejection No. 1

Claims 1 and 11 recite a “a preliminary order for crediting accounts associated with the intended recipients.” Claims 8, 9 and 12 each recite “a preliminary order for crediting the accounts associated with the certain subscribers.” The Examiner contends that the disclosure of the “. . . preliminary order for crediting the accounts . . . ,” does not provide details. Based on this perceived lack of disclosure within the written description, the Examiner states that “[f]or examination purposes, the Examiner will interpret the phrase . . . [to mean] a maximum amount or a fixed amount that a provider is willing to compensate those customers that access the information.” (December 15, 2005 Detailed Action, page 3.)

Appellant respectfully disagrees with the Examiner’s position. The specification clearly explains that “[t]he preliminary nature of the order means that the actual crediting is not yet accomplished, because there is no evidence about the intended recipients actually receiving the information or service to be transmitted.” (Specification, page 7, lines 30-34.) Once there is evidence that the intended recipients have actually received the information or service to be transmitted, then the crediting will occur. Further, the Specification discloses other embodiments of the present invention and discusses the preliminary order, e.g., page 9, lines 20-35.

Because there is clear disclosure within the specification for the claim language of a “preliminary order for crediting the accounts . . . ,” there is no basis for the Examiner to interpret the phrase to mean a maximum or fixed amount. The Examiner’s interpretation of this claim language does not comport with the unequivocal definition provided by the above-cited portion of the specification. Indeed, in contrast to the Examiner’s interpretation of “a maximum amount or a fixed amount” the specification clearly states that “the actual crediting is not yet accomplished.” Accordingly, Appellant submits that the written description does particularly point out the claimed subject matter.



The Examiner relies on Goldhaber, Fig. 2 and the related text as disclosing “transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients.” (December 15, 2005 Detailed Action, page 4.) Appellant submits that Goldhaber Fig. 2 and its related text, (*see* col. 10, lines 8-38), discloses that a consumer requests information, the consumer is asked to compensate the provider for the information, the consumer pays for the information, and the provider provides the information. This section of Goldhaber has nothing to do with transmitting a preliminary order for crediting accounts, as required by the claimed invention. In fact this is the “positive priced information system.” As noted above, even in the negative priced information system of Fig. 3, the preliminary order is not used by Goldhaber.

Further, the Examiner contends that the Appellant has relied on features not present in the claims. (*See*, December 15, 2005 Detailed Action, page 9.) However, in the previous Response, Appellant merely asserted that one of the advantages of the “preliminary” feature is that by transmitting a preliminary crediting order before transmitting the information or service to the subscriber terminals, there is a reduction in the service provider's chance for cheating, i.e., the accounting system already has the credit information and will act on it in response to the indication of access. This assertion of advantage should not distract the Examiner from the fact that the “preliminary” feature recited in the claims is distinguishable over the Goldhaber reference itself.

Claims 2-6 and 11 depend from claim 1. Claims 9-10 and 12 depend from claim 8. These dependent claims are patentable over Goldhaber for at least the same reasons as their respective base claims. Therefore, for the reasons stated above, Appellant respectfully submits that Goldhaber does not disclose each and every feature of claims 1-6 and 8-12,

### Grounds of Rejection No. 3

Independent claim 7 is directed to a method for distributing information or services through a computer or a cellular network, and recites the step of crediting an account, which includes certain recited substeps. The Examiner acknowledges that Goldhaber fails to disclose “that crediting an account associated with said certain recipient comprises the substeps of defining the time it has

taken for said indication to be received and crediting said account by an amount which is inversely proportional to said time.” (December 15, 2005 Detailed Action, page 7.) However, the Examiner contends that Goldhaber discloses the use of time-sensitive incentives such as coupons and relies on the Examiner’s own personal knowledge that it would have been obvious “to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber’s response time.” (Emphasis added.)

Appellant submits that Goldhaber’s disclosure of coupons does not make obvious the claimed feature of “crediting said account by an amount which is inversely proportional to said time,” where the time is “the time taken for said indication to be received.” Goldhaber neither discloses, nor suggests, that its coupons are time-sensitive. And even assuming that Goldhaber were to suggest that the coupons were time-sensitive, such coupons typically have full value until their expiration date, after which they have no value, a step function. Thus they do not decrease in value with time. They either have value or not. As a result, it would not have been obvious to one of ordinary skill to arrive at assigning value to the coupon which is inversely proportional to the time taken to receive an indication that a recipient accessed a piece of information, a declining ramp function.

Appellant submits that the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, *citing Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).) Further, the Examiner’s example does not work in the same way as the claimed invention.

Additionally, the Examiner’s statement of what was known in the art at the time of the invention is not supported by any “concrete evidence in the record . . . .” (See MPEP § 2144.04(c), *citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).) Accordingly in the previous response, Appellant requested that the Examiner support this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). In the Advisory Action mailed June 7, 2006, the Examiner seems to be addressing his obligation under the rules by once again asserting



Additionally, in formulating the rejection of claim 7 in the December 15, 2005 Final Office Action, the Examiner has again used vague language, (i.e., “to extend Goldhaber to disclose time-sensitive credits, **perhaps** based on a subscriber’s response time”). Such a statement with its vague language (i.e., “perhaps”) could hardly be interpreted as asserting facts “capable of instant and unquestionable demonstration as being well known.” There has certainly been no demonstration that the Examiner’s assertion is “unquestionable.” There is just as much chance that old information will be more valuable as it will be less valuable. Old movies and other collectables clearly increase in value with time.

Independent claim 13 is directed to a method of distributing information or services through a computer or cellular network, and recites the steps “crediting an account associated with said certain recipient, wherein the step of crediting an account comprises the substeps of ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and crediting said account associated with said certain recipient based on the order ranking”

The Examiner acknowledges that “Goldhaber *does not* specifically disclose crediting an account by (a) ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and (b) crediting said account associated with said certain recipient based on the order ranking.” (Detailed Action, page 8. (Emphasis in original.))

The Examiner unequivocally admits that Goldhaber does not teach these features of claim 13. In an attempt to make up for Goldhaber’s deficiencies, the Examiner argues that it is well known to reward early responders, and that this is admitted prior art. From this position, the Examiner argues that the features of claim 13 would have been obvious.

As discussed above, Appellant again submits that there has been no admission that anything is prior art. Moreover, even if it were known to reward early responders, it still would have not been obvious to rank the order of responses of recipients, and credit accounts based on the ranking. Simply knowing to reward early responders, e.g., to provide a discount for those who register before

a certain date, would result in rewarding responders based on a point in time. It would not suggest that responders be ranked individually by the time when they respond, so that even early responders are ranked according to how early they are. Thus, claim 13 is patentable over Goldhaber for at least these reasons.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (emphasis added). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Appellant's disclosure.” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As demonstrated above, Appellants submit that the Examiner has not shown any objective teaching from the cited art that would lead an individual at the time of the invention to modify Goldhaber as done by the Examiner. A person of ordinary skill in the art in possession of Goldhaber at the time of the invention would not be motivated to modify Goldhaber's coupons to be valued on an inverse time-variant basis or a ranking of responses. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

For all of the reasons set forth above, the rejections of claims 1-13 should be reversed. Appellant respectfully requests that the application be remanded to the Primary Examiner with an instruction to withdraw the rejections, and pass the case to allowance.

Respectfully submitted,

Dated: May 11, 2007

By 

Richard J. Katz

Registration No.: 47,698

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Appellant

**APPENDIXES**

**CLAIMS APPENDIX**

The following is a copy of the claims involved in the appeal:

1. A method for distributing information or services through a computer or cellular network, comprising the steps of:  
composing a piece of information or service to be distributed through the computer or cellular network;  
compiling a list of intended recipients;  
transmitting through the computer or cellular network a preliminary order for crediting accounts associated with the intended recipients;  
releasing said piece of information or service so that said piece of information or service becomes accessible to the recipients appearing on said list; and  
as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient.
2. The method according to claim 1, wherein the step of crediting an account associated with said certain recipient comprises the substeps of:  
identifying an account representing the rights of said certain recipient to use certain services through said network; and  
crediting said identified account.
3. The method according to claim 1, wherein the step of crediting an account associated with said certain recipient comprises the substeps of:  
identifying an account the identifier of which has been intentionally provided by said certain recipient; and  
crediting said identified account.

4. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substep of indicating to at least part of the recipients appearing on said list that accessing said piece of information or service will cause a certain account associated with said certain recipient to be credited.
5. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substep of transmitting said piece of information or service to a number of subscriber terminals in the computer or cellular network.
6. The method according to claim 1, wherein the step of releasing said piece of information or service comprises the substeps of:  
storing said piece of information or service to a place which is accessible for subscriber terminals through the computer or cellular network; and  
transmitting to a number of subscriber terminals an indication of said piece of information or service being available at said place.
7. A method for distributing information or services through a computer or cellular network, comprising the steps of:  
composing a piece of information or service to be distributed through the computer or cellular network;  
compiling a list of intended recipients;  
releasing said piece of information or service so that said piece of information or service becomes accessible to the recipients appearing on said list; and  
as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient,  
wherein the step of crediting an account comprises the substeps of:  
defining the time taken for said indication to be received; and

crediting said account by an amount which is inversely proportional to said time.

8. An arrangement for distributing information or services through a network, comprising:
  - a source of information or services;
  - a number of subscriber terminals;
  - means for maintaining accounts associated with certain subscribers;
  - means for transmitting to the means for maintaining accounts a preliminary order for crediting the accounts associated with the certain subscribers;
  - means for providing an indication of a certain recipient having accessed a piece of information or service; and
  - means for responding to said indication by crediting an account associated with said certain recipient.
9. The arrangement according to claim 8, further comprising:
  - a service provider's terminal;
  - a database server; and
  - an account server,wherein said service provider's terminal is arranged to operate as said source of information or services, said account server is arranged to operate as said means for maintaining accounts associated with certain subscribers and for receiving the preliminary order for crediting the accounts associated with the certain subscribers, and said database server is arranged to maintain data identifying certain subscribers and associating the identified subscribers with certain contact information through which information or services is deliverable to the identified subscribers.

10. The arrangement according to claim 9, further comprising a service or information server which is arranged to store pieces of information or services in a form accessible to subscriber terminals.
11. The method according to claim 1, wherein the preliminary order for crediting accounts associated with the intended recipients includes said piece of information or service.
12. The arrangement according to claim 8, wherein the preliminary order for crediting the accounts associated with the certain subscribers includes said piece of information or service.
13. A method for distributing information or services through a computer or cellular network, comprising the steps of:
  - composing a piece of information or service to be distributed through the computer or cellular network;
  - compiling a list of intended recipients;
  - releasing said piece of information or service so that said piece of information or service becomes accessible to the recipients appearing on said list; and
  - as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient, wherein the step of crediting an account comprises the substeps of:
    - ranking the order in which said certain recipient provides the reception indication relative to other of said intended recipients; and
    - crediting said account associated with said certain recipient based on the order ranking.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings for this matter.